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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,528	07/02/2003	Harold M. Krisbergh	TVG/9575-1U2	4548

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EXAMINER	
KOENIG, ANDREW Y	
ART UNIT	**PAPER NUMBER**
2611	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/613,528	KRISBERGH ET AL.	
	Examiner	Art Unit	
	Andrew Y Koenig	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-28 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-28 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 1/18/04.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

This application repeats a substantial portion of prior Application No. 08/993,904, filed 18 December 1997, and adds additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

The examiner notes that the additional disclosure was objected to as being "new matter" in the parent application (08/993,904) and was not entered. However, in the instant case, the additional disclosure has been re-inserted, but is not supported by the originally filed disclosure of the parent (08/993,904). Consequently, the instant application is a CIP of the parent (08/993,904).

Inventorship

2. The instant application (10/613,528) claims priority to application 08/630,397 now U.S. Patent Number 5,999,970. The inventive entity of the patent resulting from the parent application (08/630,397 now U.S. Patent Number 5,999,970, see Certificate of Correction) is different from the instant application (e.g. David Dill was added to the parent application and is missing from the child application). Since, the instant specification has equivalent disclosures and adds subject matter; the inventive entity of the instant application is put on question. The instant application should address the discrepancy, in that the instant application has similar claims and is missing an inventor.

The applicant must conform to the rules as specified in 37 CFR 1.48 (b). The applicant currently does not have priority to Application No. 08/630,390 now U.S. Patent 5,999,970 until the applicant is compliant with 37 CFR 1.48. However, for the rest of this Office Action, the instant application will **assume** that the instant application has priority to application number 08/630,390.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12, 14-24, 28, and 29 of U. S. Patent No. 5,999,970. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application claims are inclusive in that the claimed subject matter is the same only in a broader scope.

Allowance of the instant application would permit an unwarranted timewise extension.

Claims 1-5 and 7-13 of the instant application correspond to claims 1-12 of U. S. Patent No. 5,999,970, respectively.

Claims 15-17 and 19-26 of the instant application correspond to claims 14-24 of U. S. Patent No. 5,999,970, respectively.

Claim 28 of the instant application corresponds to claims 28 and 29 of U. S. Patent No. 5,999,970.

Claims 6 and 18 of the instant application recite an Internet router interfaced to the headend server for routing transmitted Internet commands and transmitted Internet information, which is taught by U.S. Patent 5,761,602 to Wagner et al.

Claims 14 and 27 of the instant application recites the limitation of "the step of rendering screens at the headend server for display at the display device interfaced to the terminal," which is taught by U.S. Patent 5,485,197 to Hoarty.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 5, 8-10, 13, 15, 17, 20-22, 25, 26, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 5,572,517 to Safadi.

Regarding claims 1 and 15, Safadi teaches a television distribution network with a headend (claimed network headend), a plurality of set top terminals (STTs)(claimed terminal ends), a plurality of upstream channels (Abstract, col. 3, ll. 50-62), and a plurality of downstream channels for television transmissions (col. 6, ll. 28-44). Safadi teaches a network for distributing signals from the headend to the terminals (col. 13, ll. 24-41), which reads on headend distribution network. Safadi teaches a plurality of terminals (fig. 1), where each terminal displays a selected television program (fig. 5; col. 14, ll. 35-54). Safadi teaches the use of a bi-directional communications within a cable system, and Safadi teaches that these systems permit the subscriber to select specific video programming, consumer services which are used, and other services (col. 7, ll. 46-67). Whereas, the invention of Safadi teaches bi-directional techniques, the system of Safadi discloses a remote control (144), which transmits an infrared signal to the processor in the set top terminal (STT). Additionally, the STT can initiate a service

request and communicates with the network controller (62) (col. 16, ll. 49-67), for services such as pay-per view (PPV), impulse pay-per-view (IPPV), and non-video-on-demand, etc. (col. 7, ll. 46-67). As shown if figure 5, Safadi teaches a remote control and an IR emitter (col. 15, ll. 10-14), which clearly sends a command for the information source. Safadi teaches a data transmitter (fig. 5, label 142; col. 15, ll. 3-9), which reads on an upstream transmitter. Safadi teaches video information providers (VIPs) (col. 6, ll. 9-11), which reads on headend server. Referring to figure 3, labels 60, 62, and 64, Safadi teaches a demodulator, a network controller NC1000, and ATM services MUX (col. 9-10, ll. 64-5), which reads on upstream receiver. Safadi teaches an ITEM (col. 10, ll. 6-29), which reads on a data encoder. Safadi teaches a processor that contains an encryption/decryption module, which reads on a data decoder at the terminal (col. 14, ll. 35-53).

Regarding claim 2, Safadi teaches the user selecting the downstream channel (col. 14, ll. 35-53); clearly an input device must be used to receive user input.

Regarding claims 5 and 17, Safadi teaches a remote control with an infrared transmitter (col. 15, ll. 10-14).

Regarding claims 8 and 20, Safadi teaches time division multiple access (TDMA) for an upstream channel (Abstract, col. 3, ll. 50-62), which reads on plurality of upstream time slots.

Regarding claims 9 and 21, Safadi teaches a session request slot (col. 2-3, ll. 56-4, col. 3, ll. 50-62).

Regarding claims 10 and 22, Safadi teaches the headend server dynamically assigning the terminal an upstream slot (col. 2, ll. 56-63, col. 3, ll. 50-62).

Regarding claims 13 and 25, Safadi teaches a plurality of input devices, upstream transmitters, data decoders, and a headend server, see claim 1. Safadi teaches a terminal requesting services (Abstract); clearly, the server receives a plurality of commands from the terminals and forwards the commands to a headend server (fig. 1). The VIP responds by transmitting information to the headend (col. 7, ll. 16-27), which is encoded and transmitted to the terminals to be decoded (col. 7, ll. 56-66).

Regarding claim 26, Safadi teaches sending messages via transmitter (fig. 5, label 142) to the headend server. Clearly, the headend server routes the messages to the second terminal in order to associate and deliver services to the user (col. 7, ll. 16-55).

Regarding claim 28, the network configuration has been addressed in claims 38 and 52. Safadi teaches dynamic TDMA (col. 2-3, ll. 56-4, col. 3, ll. 50-62), which reads on the transmitting and receiving steps of the first and second data and acknowledgements. Safadi teaches sending a request for a time-slot (claimed first data) and the headend responding by sending an acknowledgement of the time slot (claimed first acknowledgement). The user device receives a time slot from headend, which permits the user to request for a service that initiates the headend to send a second data on the downstream channel of the requested service to the user. As shown in figs. 8A, and 8B, the STT sends a second data to the headend to terminate the communication (step 310), and the headend acknowledges with a response to all

the STTs that the channel is available (fig. 8b, label 316 and 318; col. 18, ll. 1-19), which reads on the second data and second acknowledgment as claimed. The data encoding/decoding is addressed in claims 50 and 62.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 3, 4, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,572,517 to Safadi in view of U.S. Patent 5,375,160 to Guidon et al.

Regarding claims 3 and 16, Safadi is silent on teaching a keyboard as an input device. Guidon teaches using a keyboard as an input device (col. 4, ll. 40-59). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Safadi by using a keyboard as an input device as taught by Guidon in order to enhance the user interaction and providing an easier input.

Regarding claim 4, Safadi is silent on teaching a keyboard as an input device. Guidon teaches using an infrared keyboard (col. 4, ll. 40-59). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Safadi by using an infrared keyboard as taught by Guidon in order to increase mobility of the user and the keyboard.

9. Claims 6 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,572,517 to Safadi in view of U.S. Patent 5,761,602 to Wagner et al.

Regarding claims 6 and 18, Safadi is silent on teaches the information source as an Internet service provider. Wagner teaches an Internet service provider (col. 4-5, ll. 60-6) and also teaches a router (fig. 1, label 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Safadi by using an Internet service provider and routers as taught by Hoarty in order to send Internet traffic to and from the user stations thereby enable more services.

10. Claims 7, 14, 19, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,572,517 to Safadi in view of U.S. Patent 5,485,197 to Hoarty.

Regarding claims 7 and 19, Safadi teaches sending live broadcasts, archived broadcasts, or interactive content (col. 7, ll. 6-10). However, Safadi is silent on teaches a graphics processor to convert the signals. Hoarty teaches a modulator card (fig. 14, label 141) for the converting the transmitted information to a compressed stream (11: 6-37). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Safadi by converting the stream as taught by Hoarty in order to gain more compression.

Regarding claims 14 and 27, Safadi is silent on a screen renderer. Hoarty teaches circuitry for generating a display of a carousel on a subscriber's television (Abstract), which reads on a screen renderer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Safadi by implementing a screen renderer as taught by Hoarty in order to display additional information to the user along with the video information.

11. Claims 11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,572,517 to Safadi in view of U.S. Patent 5,581,555 to Dubberly et al.

Regarding claims 11 and 23, Safadi is silent on detecting noise levels. Dubberly teaches detecting noise levels in the upstream channel and switching to another channel (col. 40, ll. 24-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Safadi by detecting noise levels and switching if necessary as taught by Dubberly in order to attempt another channel with less noise.

12. Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,572,517 to Safadi in view of U.S. Patent 5,309,514 to Johnson et al.

Regarding claims 12 and 24, Safadi is silent on transmitting at a higher level upon detecting noise. Johnson teaches that increasing the amplitude reduces the effects of noise (col. 12-13, ll. 60-9). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to increase the transmitting power as taught by Johnson in order to overcome the effects of the noise. Official Notice is taken that detecting noise at the headend is well known in the art. Therefore, it would have been obvious to of ordinary skill in the art at the time the invention was made to modify Safadi by detecting noise at the headend in order to alleviate the processing required at the terminals.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y Koenig whose telephone number is (703) 306-0399. The examiner can normally be reached on M-Th (7:30 - 6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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CHRIS GRANT
PRIMARY EXAMINER